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09/916,971	07/26/2001	Phyllis A. Ellendman	10007711-1	8593
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HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400				ROSWELL, MICHAEL
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/916,971

Filing Date: July 26, 2001

Appellant(s): ELLENDMAN, PHYLLIS A.

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Douglas L. Weller  
Reg. No. 30,506  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12 June 2006 appealing from the Office action

mailed 14 March 2006.

### **(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

## **(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

## **(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

## **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,671,718 Meister 12-2003

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Meister et al (US Patent 6,671,718), hereinafter Meister.

Regarding claim 1, Meister teaches a method by which an electronic mail system sends an e-mail message, checking by the electronic mail system a field of the e-mail message used to specify addresses to be removed by the electronic mail system from a "To" field, and by removing by the electronic mail system from any addresses specified in the "To" field of the e-mail message, any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field, and sending the e-mail message, taught as the use of a "Modify Addresses" control of the e-mail message related to a selected address field (See Fig. 2) that allows a user to selectively modify and remove the intended recipients of an e-mail message, including those found in the "To" field, at col. 3, lines 45-50.

Regarding claims 2-3, Meister teaches removing selected addresses specified in a "Cc" field and a "Bcc" field, taught as the use of a "Modify Addresses" control of the e-mail message that allows a user to selectively modify and remove the intended recipients of an e-mail message, including those found in the "To" field, at col. 3, lines 45-50.

Regarding claims 4-5, Meister teaches at least one subset of addressed to be removed from the "To" field being specified using a group list or at least one group list and at least one individually listed addresses, taught as the ability to assign aliases to groups of e-mail

addresses, as seen in Fig. 3, and the selective removal of specified addresses, at col. 3, lines 45-50.

Regarding claim 6, Meister teaches the ability to remove addresses from a "To" field by way of a dialog for removing addresses from any and all fields in an e-mail message used to specify addressees, at col. 3, lines 45-50.

Regarding claims 7-8, Meister teaches checking by the electronic mail system a field of the e-mail message used to specify addresses to be removed by the electronic mail system from all address fields, and the ability to remove addresses from a "To" field, a "Cc" field and a "Bcc" field by way of a dialog for removing addresses from any and all fields in an e-mail message used to specify addressees, at col. 3, lines 45-50.

Regarding claim 9, Meister teaches a "To" field for listing primary addresses to receive a message, and a field used to specify to the electronic mail system addresses to be removed by the electronic mail system from the "To" field in preparation for sending the message, taught as the use of a "Modify Addresses" control of the e-mail message related to a selected address field (See Fig. 2) that allows a user to selectively modify and remove the intended recipients of an e-mail message, including those found in the "To" field, at col. 3, lines 45-50.

Regarding claims 10-11, and 13, Meister teaches removing selected addresses specified in a "Cc" field and a "Bcc" field, taught as the use of a "Modify Addresses" control of the e-mail message that allows a user to selectively modify and remove the intended recipients of an e-mail message, including those found in the "To" field, at col. 3, lines 45-50.

Regarding claim 12, Meister teaches a dialog for removing addresses from any and all fields in an e-mail message used to specify addressees, at col. 3, lines 45-50.

Regarding claim 14, Meister teaches removing selected addresses specified in a "To" field, a "Cc" field and a "Bcc" field by way of a field used to specify to the electronic mail system addresses to be removed by the electronic mail system from the address fields, taught as the use of a "Modify Addresses" control of the e-mail message related to a selected address field (See Fig. 2) that allows a user to selectively modify and remove the intended recipients of an e-mail message, at col. 3, lines 45-50.

#### **(10) Response to Argument**

Appellant's arguments of independent claims 1, 8, 9, and 14 on pages 5 through 15 similarly seek to highlight the difference between the claimed "field of the e-mail message used to specify addresses to be removed by the electronic mail system" and the cited "control of the e-mail message that allows a user to selectively modify and remove the intended recipients of an e-mail message". Specifically, appellant has argued that the Meister reference teaches a control that allows a user to manually remove e-mail addresses (through the "Modify Addresses" control and confirmation checkboxes 50 of Fig. 2), and that the disclosed control is different from the claimed "field of an e-mail message". The examiner respectfully disagrees.

As is apparent from the above rejection, Meister teaches an electronic mail system wherein specified addresses are removed from a list of addresses prior to the sending of an e-mail message, similar to appellant's claimed invention. Meister shows the removal of addresses from those listed in a "To" field, a "Cc" field, and a "Bcc" field, also similarly claimed by

appellant. This removal is done by way of a "Modify Addresses" control within the e-mail message.

As to the difference between the "control" of Meister and the "field of the e-mail message used to specify addresses to be removed", the examiner contends that appellant has failed to recognize the alias fields and address fields found in the "Modify Addresses" dialog box as such "field[s] of the e-mail message used to specify addresses to be removed". By manipulating the confirmation checkbox **50**, the address field **42** is used to specify whether or not the listed address will receive the e-mail message. See col. 3, lines 57-66.

Therefore, the alias and address fields seen in Fig. 2 are analogous to appellant's claimed "field of the e-mail message used to specify addresses to be removed," as the user may selectively specify which addresses will receive the message and which will not.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Roswell, Examiner

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